

DOCKET NO: 242320US8

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
YOSHIKAZU KATO : EXAMINER: COPPOLA, JACOB C.
SERIAL NO: 10/656,274 :
FILED: SEPTEMBER 8, 2003 : GROUP ART UNIT: 3621
FOR: INFORMATION PROCESSING :
APPARATUS, INFORMATION
PROCESSING METHOD,
STORAGE MEDIUM, AND
PROGRAM

REPLY BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

This is in Reply to the Supplementary Examiner's Answer dated January 28, 2011.

I. STATUS OF THE CLAIMS

Claims 1-5 and 7-9 are pending. Claims 1-5 and 7-9 stand rejected. Claim 6 is canceled without prejudice or disclaimer. The rejection of Claims 1-5 and 7-9 is herein appealed.

II. GROUNDS FOR REJECTION TO BE REVIEWED ON APPEAL

Whether Claims 1-3 and 7-9 are directed to statutory subject matter under 35 U.S.C. §101; whether Claims 1-3 are indefinite under 35 U.S.C. §112, second paragraph; whether Claims 1, 3-5, 7 and 9 are unpatentable under 35 U.S.C. §103(a) over Kent (U.S. Publication

2002/0040374) in view of Nii (U.S. Publication 2002/0065730); whether Claims 2 and 8 are unpatentable under 35 U.S.C. §103(a) over Kent in view of Nii in further view of Applicant's Own Admission (herein "AOA"); whether Claims 7-9 are indefinite under 35 U.S.C. §112, second paragraph (New Ground of Rejection).

III. SUPPLEMENTARY EXAMINER'S ANSWER

Initially, Appellants submit that the Supplementary Examiner's Answer is inappropriately filed in response to the Reply Brief of October 15, 2010 ("Reply Brief"). In this regard, MPEP 1207.05 states, *inter alia*, that:

Every supplemental examiner's answer must be approved by a Technology Center (TC) Director or designee. The examiner may furnish a supplemental examiner's answer in response to any one of the following:

- (A) *A reply brief that raises new issues.* The examiner may NOT include a new ground of rejection in the supplemental examiner's answer responding to a reply brief. See 37 CFR 41.43(a)(2). Appellant may file another reply brief in response to the supplemental examiner's answer within two months from the mailing of the supplemental answer. See MPEP § 1208.
- (B) *A remand by the Board for further consideration of a rejection under 37 CFR 41.50(a).* See MPEP § 1211.01. In response to a supplemental examiner's answer that is written in response to a remand by the Board for further consideration of a rejection, appellant must either file: (1) a reply under 37 CFR 1.111 to request that prosecution be reopened; or (2) a reply brief to request that the appeal be maintained, within two months from the mailing of the supplemental examiner's answer, to avoid *sua sponte* dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding. Examiner may include a new ground of rejection in the supplemental examiner's answer responding to a remand by

the Board for further consideration of a rejection. See MPEP § 1207.03.

(C) A remand by the Board for other purposes that are not for further consideration of a rejection under 37 CFR 41.50(a). The examiner may NOT include a new ground of rejection in the supplemental examiner's answer responding to a remand by the Board, unless the remand is for further consideration of a rejection under 37 CFR 41.50(a) (see item B above). Appellant may file a reply brief with two months from the mailing of the supplemental answer.

As the Reply Brief does not raise any new issues and the Supplementary Examiner's Answer fails to identify any new issues in the Reply Brief, it is respectfully submitted that Supplementary Examiner's Answer is inappropriate and should not be considered. However, in the event the Supplementary Examiner's Answer is considered, a brief reply to the points raised in the Supplementary Examiner's Answer is provided below.

IV. ARGUMENT

The Supplementary Examiner's Answer clarifies the new grounds of rejection with respect to the Examiner's Answer of August 19, 2010 and addresses selected arguments from the Reply Brief. Nevertheless, Appellants maintain that the final rejections are improper for the reasons provided in the Appeal Brief of November 11, 2009 ("Appeal Brief") and Reply Brief, and for the following additional reasons, which address points raised in the Supplemental Examiner's Answer.

A. FINDINGS OF FACT

In reply to the Examiner's comments on page 3 with respect to the Findings of Fact, Appellants respectfully submit that this issue has already been adequately addressed at least in the Appeal Brief and Reply Brief.

B. CORRESPONDING STRUCTURE OF THE MEANS PLUS FUNCTION ELEMENTS

In reply to the Examiner's assertions on pages 4 through 7 with respect to footnote 3 on page 2 of the Appeal Brief of November 11, 2009, Appellants respectfully submit that this issue has already been adequately addressed at least in the Reply Brief.

C. APPELLANT'S FOURTH ATTEMPT AT CORRESPONDING STRUCTURE FOR CLAIMS 1-3

With respect to the Appellants identification of corresponding structure for corresponding means Claims 1-3, the Supplemental Examiner's Answer asserts that Appellants arguments made on pages 9-10 of the Reply brief were discussed for the first time in the Reply Brief and are thereby waived as not having been discussed in the Appeal Brief.¹ In reply to these assertions by the Examiner, Appellants note that the Reply Brief was merely responding to comments made by the Examiner in the Examiner's Answer. For example, the Examiner's Answer states that "the original specification does not describe - let alone even indicate - a particular algorithm that performs the various phrases that invoke 35 U.S.C. §112, sixth paragraph."² Further, the Examiner's Answer includes statements specifically addressing the means elements by stating "like *Blackboard*, Appellants' specification is completely

¹ Supplementary Examiner's Answer at pages 7-9.

² *Id.* at page 28, lines 5-9.

silent as to how the claimed function is performed.”³ Accordingly, as Applicants were merely responding to comments made in the Examiner’s Answer, it is respectfully submitted that the above-noted comments made in the Reply Brief should be fully considered.

D. OFFICIAL NOTICE ARGUMENTS

In reply to the Examiner’s assertions on pages 9 through 11 with respect to the Examiner’s Official Notice arguments, Appellants respectfully submit that this issue has already been adequately addressed at least in the Appeal Brief and Reply Brief.

E. APPELLANT’S RESPONSE TO THE NEW GROUNDS OF REJECTION, §112 2ND - HYBRID CLAIMS

In reply to the Examiner’s assertions on pages 12 through 15 with respect to the Examiner’s hybrid claim arguments, Appellants respectfully submit that this issue has already been adequately addressed at least in the Appeal Brief and Reply Brief.

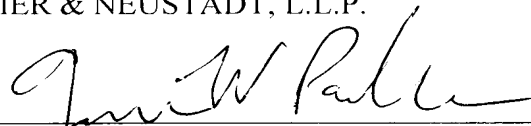
³ Id. at page 40, lines 1-2.

V. CONCLUSION

In view of the foregoing, it is respectfully submitted that the cited references, whether considered alone or in combination, fail to disclose or suggest the combined features set forth in Claims 1-5 and 7-9. Accordingly, it is respectfully requested that the rejections of Claims 1-5 and 7-9 be reversed. Further, it is respectfully submitted that all other rejections are improper and should be reversed.

Respectfully submitted,

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